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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,829	05/01/2001	Hardarshan S. Valia	ISP00	4969
27187	7590	10/02/2006	EXAMINER	
BAKER & DANIELS LLP 205 W. JEFFERSON BOULEVARD SUITE 250 SOUTH BEND, IN 46601			BHAT, NINA	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,829

Applicant(s)

VALIA ET AL.

Examiner

N. Bhat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments and the evidence provided regarding the apparent specific gravity of coal as well as the other non-patent literature supplied to the office has been fully and carefully considered. Upon updating the search, two new references came to the examiner's attention which are applicable under 102(e)/103 (a). A new ground of rejection follows:
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-9 and 14-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barkdoll USP 6,290,494.

In claim 1 of the Barkdoll Patent 6,290,494 states:

feeding particulate coal to the charging plate between the side walls and second end wall of the coal guide section and to the coal guide section between the second and third end walls to form first and second coal beds;
compacting the coal in the first coal bed between the retractable side walls and first and second end walls;
removing the pusher door from the coking oven entrance;
removing the coke door from the oven exit;

The steps as taught in Barkdoll fully anticipates applicants method claims of providing a container the container would be the charging plate in association with the retractable sidewalls in the chamber. The coking oven is a non-recovery type coke oven, which is used in making the

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coke. Admittedly the apparent specific gravity has not been specifically taught however, the compaction method taught in Barkdoll imparts the same type of force to the coal, the heating takes place in a coke oven it would have been obvious if not inherent in the method described in Barkdoll to produce a coke with an apparent specific gravity of about 1.05. The rationale for making this rejection is consistent with the case law of *In re Best* 562 F2d. 1252, 1255 n.4, 195 USPQ 430, 433, where in *Best* the Court found that where applicant claims a composition in this case the coke, in terms of a function property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed, i.e. the apparent specific gravity, the examiner may make a rejection under both 35 USC 102 and 103. The rationale applies to a product or process wherein the process claim claims a product (the coke) in terms of function, property or characteristic (the apparent specific gravity). The rationale is as follows, the loose coal is compacted and then subjected to a coking oven. The coking oven is a non-recovery type-coking oven. The apparent specific gravity function is inherent in the process as described.

4. Claims 1-3, 5-9 and 14-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sturgulewski.

Sturgulewski teach a coal compaction system and method for anon-recovery coke oven which provides improved coal charging and coke discharging. The non-recovery coke oven includes a arch roof, two side walls and floor forming an oven chamber. A coal bed rests on the floor of the chamber. The coke oven is initially heated by a fuel gas burner inserted temporarily into an opening in the oven door. A bed of coal is then inserted into the oven through the charging doors and the surface of the coal bed generates combustible gases due to radiant energy absorbed from the oven door. There is a non-cantilevered coal charging conveyor sled compaction system which compacts the loose coal prior to coking.[Note Column 3, lines 1

through Column 4, line 62.] Sturgulewski teaches that the non-cantilevered coal bed vibration compactor system for a non-recovery coke oven provides a non-recovery coking process and facility which produces low cost enhanced quality, blast furnace grade coke. The coke produced in this system would inherently possess an apparent specific gravity as claimed by applicant absent an evidentiary showing this feature would not be inherent because it has been taught in Sturgulewski that loose coal is compacted and then subjected to a coking oven. The coking oven is a non-recovery type-coking oven. The apparent specific gravity function is inherent in the process as described. [Note MPEP 2112, section III discussion of *In re Best cited above*; *Ex parte Levy*, 17 USPQ2d 1461,1464].

5. Claims 10-12 are objected to as being dependent upon a rejected base claim but would be allowable if re-written in independent form. The prior art fails to teach and/or suggest the quenching step as claimed by applicant.

6. Claim 13 is allowable over the prior art of record as the first container and second container in combination with the compaction steps as claimed by applicant. There is no suggestion of the quenching steps as claimed in the process described by applicant.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 571-272-1397. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



N. Bhat
Primary Examiner
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